

REMARKS/ARGUMENTS

A PETITION FOR EXTENSION OF TIME has been filed, concurrently with this Amendment, extending the time for response to the Official Action one (1) month, from December 27, 2004, to January 27, 2005.

As a result of this Amendment, claims 17-20 are under active consideration in the subject patent application.

In the Official Action, the Examiner has:

- (1) acknowledged Applicants' election without traverse of claims 17-21;
- (2) objected to claim 18 for informalities;
- (3) objected to claim 21 under 37 C.F.R. 1.75(c), as allegedly being in improper dependent form;
- (4) rejected claim 17-21 under the judicially created doctrine of double patenting over claim 1 of U.S. Patent No. 5,977,554;
- (5) rejected claims 17, 18 and 21 under 35 U.S.C. § 103(a) in view of the proposed combination of U.S. Patent No. 4,788,648, issued to Ferretti et al. (the "Ferretti reference"), and U.S. Patent No. 6,336,362, issued to Duenas (the "Duenas reference"); and
- (6) rejected claims 19-20 under 35 U.S.C. § 103(a) in view of the proposed combination of U.S. Patent No. 4,788,648, issued to Ferretti et al., and U.S. Patent No. 4,487,065, issued to Carlin et al. (the "Carlin reference").

With regard to Item 1, no comment appears necessary.

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With regard to Items 2, 3, and 4, claim 18 has been amended so as to place the word -- existing -- between the words "determined" and "material" as suggested by the Examiner. Reconsideration and withdrawal of the objection to claim 18 are requested. Claim 21 has been canceled without prejudice to Applicant's right to pursue the subject matter of claim 21 in related applications.

The Examiner has taken the position that claims 17-21 present subject matter that is an obvious variation of the invention claimed in U.S. Patent No. 6,366,829. In other words the Examiner admits that the subject matter of claims 17-21 is an obvious variation of the invention defined in the claims of U.S. Patent No. 6,366,829, and thus emanating from a common conception of the invention.

A Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Pending Second Application (Prior Patent) is attached to this response and is believed to be in compliance with 37 C.F.R. §1.321(c). The Terminal Disclaimer has been signed by an Attorney of Record in the case. The Commissioner is hereby authorized to charge the fee, namely, \$130.00, required in connection with the Terminal Disclaimer, to Deposit Account No. 04-1679. Applicant respectfully submits that the foregoing Terminal Disclaimer overcomes the Examiner's Double Patenting Rejection. Reconsideration and withdrawal of the Double Patenting Rejection of claims 17-20 are requested.

With regard to Item 5, Applicant respectfully traverses the Examiner's proposed combination of Ferretti et al. with Duenas, and requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103 for the

following reasons. Applicant provides a method for a transportation carrier, such as a dry bulk hauling and delivery company, to maintain sufficient quantities of dry bulk materials at a remote manufacturing site. Applicant's method includes generating a first signal representative of an existing raw material quantity at a remote site, and then transmitting a second signal corresponding to that first signal, from the remote site to a computer at predetermined time intervals. Significantly, Applicant determines both an existing raw material quantity and a projected material usage rate for that existing raw material quantity based upon the transmitted signals. Additional raw materials are ordered from a preselected vendor based on the existing material quantity and the projected material usage rate. A transport vehicle is then provided for transporting and delivering the additional raw material from the preselected vendor to the manufacturing site so that additional raw material is supplied to the manufacturing site before the existing quantity of raw material is depleted.

The Examiner admits that the Ferretti reference does not teach or suggest time windows being representative of the future, i.e., Ferretti does not project a material usage rate. In order for a *prima facie* case of obviousness to be established by the Examiner, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . .to combine reference teachings; and the. . . references when combined must teach or suggest all the claim limitations (MPEP § 2142) The Examiner thus appears to be relying solely upon the Duenas

patent to provide both the missing teachings to Ferretti and the motivation to combine reference.

The present application is a continuation-in-part of US Patent Application Serial No. 09/167,379, titled BULK INVENTORY NETWORK SYSTEM, filed October 6, 1998, and issued as US Patent No. 6,366,829, on April 2, 2002. The Duenas patent issued on January 8, 2002, from Application Serial No. 09/235,247, filed January 22, 1999, and claiming the benefit of Provisional patent application Serial No. 60/072,215, filed January 22, 1998. Thus the Duenas reference issued less than one year from the filing date of the instant application. The claims of the Duenas reference are directed to a wholly distinct and separate invention when compared to Applicant's claimed invention.

Applicant respectfully submits that the Duenas reference is not valid prior art with respect to the instant Application (and thus not combinable with any of the prior art herein relied upon by the Examiner) since the present invention was conceived prior to January 22, 1998, and Applicant worked diligently to an actual reduction to practice of his invention in September of 1998, when a working embodiment that was suitable for its intended purpose was completed at the Nucor facility in Darlington, South Carolina. On October 6, 1998, Applicant filed US Patent Application Serial No. 09/167,379, which issued on April 2, 2002, as US Patent No. 6,366,829, and with respect to which the Examiner has admitted that the subject matter of at least claims 17-21 is an obvious variation. Thus the Examiner admits that both emanate from a common conception of the invention.

In support of Applicant's position that the Duenas reference may not be validly combined with the teachings of Ferretti, under 35 U.S. C. §103, an Affidavit under 37 C.F.R. 1.131, including exhibits A-L, executed by the inventor David B. Wallace, is attached to this Amendment. This Rule 1.131 Affidavit of David B. Wallace and its supporting Exhibits and Affidavits provide ample factual documentary evidence of Applicant's conception of his invention prior to January 22, 1998, and of his diligence in moving from conception to a reduction to practice. Accordingly, the Duenas reference is not valid prior art with respect to Applicant's invention, and is not combinable with any of the prior art herein relied upon by the Examiner. Reconsideration and withdrawal of the rejection of claims 17 and 18 under 35 U.S.C. §103 are requested.

With regard to Item 6, the Examiner next seeks to combine Ferretti with the teachings of Carlin in support of an obviousness rejection of claims 19 and 20. Applicant has presented both claims 19 and 20 in independent form so as to make clear that, unlike Ferretti, both define time windows that are representative of the future, i.e., both project a material usage rate. Carlin fails to provide these missing teachings to Ferretti. More particularly, Carlin discloses a storage tank level monitor that determines fluid levels in a storage tank. It relies upon an ultrasonic transducer for generating acoustic pulses and for receiving reflections of the acoustic pulses from a string of reference disks that produce a series of reflected acoustic signals. Significantly, Carlin's string of reference disks are made necessary because of the fluctuations in surface topography that are

inherent in fluids. No such structure is associated with Applicant's design. Carlin's processor is connected to the ultrasonic transducer and analyzes the reflected pulses for calibrating the apparatus for environmental changes in the atmosphere above a stored fluid and for determining the level of the stored fluid in the tank.

However, Ferretti teaches away from such an arrangement at col. 6, lines 22-25, as follows:

"...unpredictable erratic fluctuations in the vapor space pressure of vapor space 16 can be produced. This results in fluctuations in the output of differential pressure transducer 20. The turbulence which results in differential pressure fluctuation is caused by such factors as the pumps used to move the substance, the temperature differential of the substance being supplied to the tank and that in the tank, and the requirement that a new equilibrium between vapor space 16 and substance space 14 be established. . . . These problems may occur only periodically during occasional replenishing and drawing of substance in some applications or they may occur on a continuous basis in applications where substance is continuously drawn from tank 12. These erratic fluctuations in differential pressure cause controller 28 to produce erratic instantaneous substance level calculations. The erratic calculated values of substance level could result in false calls by modem 30 to remote display 34 unless the level calculations are smoothed by time-weighted averager 36. . . ."

Ferretti teaches away from a simple ultrasonic transducer signal reflected off the surface of a liquid since such an arrangement creates erratic level calculations. Moreover, neither Ferretti nor Carlin contemplate an ultrasonic transducer for generating acoustic pulses and for receiving reflections of the acoustic pulses that is suitable for use with dry bulk materials. A prior art reference teaches away "...if it suggests that the line of development flowing

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from the reference disclosure is unlikely to produce the result sought by the Applicant” In other words, “. . . doing what a prior art reference tries to avoid is the very antitheses of obviousness. . . .” *In re Braat*, 918 F. 2d 185, 16 U.S.P.Q.2d 1812, 1814 (C.A.F.C. 1990); *In re Dow Chem. Co.*, 837 F. 2d 469, 473, 5 U.S.P.Q.2d 1529, 1532 (C.A.F.C. 1988); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F. 3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (C.A.F.C. 1997); *Baxter Int'l Inc. v. McGaw Inc.*, 149 F. 3d 1321, 1328, 47 U.S.P.Q.2d 1225, 1230 (C.A.F.C. 1998); *In re Gurley*, 27 F. 3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (C.A.F.C. 1994); and *In re Buehler*, 515 F. 2d 1134, 1141, 185 U.S.P.Q. 781, 787 (C.C.P.A. 1975). Thus, contrary to the Examiners assertions, one of ordinary skill would not consider combining the teachings of Ferretti with those of Carlin since Ferretti suggests that Carlin’s structure would not produce reliable results. Moreover, when taken as a whole neither Carlin nor Ferretti provide teachings or a suggestion of a method for a transportation carrier to maintain sufficient quantities of dry bulk materials at a remote manufacturing site that utilizes time windows that are representative of the future, i.e., projecting a material usage rate.

Since nothing in the prior art references would lead a person of ordinary skill in the art to design a system or method like that described in the application, or defined by claims 17-20, it appears that hindsight knowledge of the present invention is the only motivation to combine these references. Applicant respectfully submits that the motivation to combine references cannot come from

the invention itself. See, *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1446. The Examiner is also referred to *In re Bond*, 910 F. 2d 831, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1990) which held that the PTO erred in rejecting a claimed invention as an obvious combination of the teachings of two prior art references when the prior art provided no teaching, suggestion, or incentive supporting the combination.

In summary, Applicant submits that the unique system and method defined by claims 17-20 are not disclosed in the prior art references, taken as a whole, and there is no teaching or suggestion in the references to support their use in the particular claimed combination. In the absence of such, the references are improperly combined. In any event claims 17-20 define over the combination of the Ferretti reference with the Carlin reference.

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Docket No. D4865-00004
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In view of the foregoing, Applicants respectfully submit that claims 17-20 are in condition for allowance. Favorable reconsideration is therefore respectfully requested. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

If a telephone conference would be of assistance in advancing prosecution of the above-identified application, Applicant's undersigned Attorney invites the Examiner to telephone him at 717-237-5516.

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Respectfully Submitted,



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